

REMARKS

Claims 1-44 are pending in the application. Claims 1, 5, 6, 21, 25, 26 and 41 have been amended, and claims 2, 22, and 42 have been cancelled. Claims 1, 21 and 41 have been amended to incorporate features formerly recited in claims 2, 22, and 42, respectively, and claims 5, 6, 25 and 26 have been amended for clarification. No new matter has been added by this amendment.

Claim Rejection under 35 U.S.C. § 102(e)

Claims 1-5, 21-25, 41 and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Daniell et al. (US Patent Publication No. 2004/0054736). To the extent this rejection has not been rendered moot by the cancellation of claims, these rejections are respectfully traversed.

Claim 1 recites a method for providing interoperability of email and instant messaging services. The method comprises receiving a request by an email recipient to respond to an email message using an instant message application, the email message received from an email sender. The method further comprises retrieving an instant message address for the email sender from storage, associating the instant message address of said email sender with an instant message composed by the email recipient, and transmitting the instant message to the instant message address using the instant message application. An email address associated with the email sender is mapped to a corresponding instant message address associated with the email sender. Claim 1, as amended, further recites transmitting history data along with the instant message. The history data includes communications exchanges previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments.

Daniell discloses an object architecture for integration of email and instant messaging. The Action points to paragraphs FIGS. 10 and 16 and paragraphs 0118-0127 as allegedly disclosing transmitting history data along with the instant message, the history data including communications exchanges previously conducted between the email recipient and the email sender, wherein the communications exchanges include at least one of email messages, instant messages, and attachments. These portions of Daniell illustrate and describe a thread history database maintained for instant messages and emails. As described in paragraph 0022

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of Daniell, a selected email message in the thread history is displayed when a users selects the email message in the thread history. Similarly, as described in paragraph 0023 of Daniell, a transcript of a selected IM chat session is displayed when a user selects the IM chat session in the thread history. Daniell does not disclose or suggest transmitting history data along with the instant message, the history data including communications exchanges previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments as set forth in clam 1.

As Daniell fails to disclose or suggest all the features recited in claim 1, Daniell does not anticipate claim 1. Therefore, claim 1 is considered allowable over Daniell.

If the position is maintained that all the features recited in claim 1 are disclosed in Daniell, it is respectfully requested that it be specifically pointed out where in Daniell there is a basis for this view.

Claims 21 and 41, as amended, recite similar features as claim 1 and are considered allowable for at least the same reasons. Claims 3-5, 23-25, and 42 depend from and include all the features recited in clams 1, 21, and 41, respectively, and are considered allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 6, 26, 43 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Szeto. Claims 7-12 and 27-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Danon (US Publication No. 2003/0110211) and further in view of Davis et al. (US Publication 2004/0158610). Claims 13 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Danon. Claims 14-18 and 34-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Atencio et al. (US Publication 2004/0210450). Claims 19, 20 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniell in view of Roskind (US Publication 2004/0128540). These rejections are respectfully traversed.

With regard to the rejection of claims 6, 26, 43, and 44, the Action relies on Szeto for the features missing from Daniell. Szeto discloses a system and method for instant messaging using an email protocol. Szeto fails to disclose or suggest transmitting history data along with the instant message, the history data including communications exchanges

previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments as set forth in independent claims 1, 21, and 41. Thus, Szeto fails to make up for the deficiencies of Daniell with regard to claims 1, 21, and 41. As claims 6, 26 and 43-44 depend from and include all the features recited in claims 1, 21 and 41, respectively, claims 6, 26, and 43-44 are considered allowable over any combination of Daniell and Szeto.

In addition, claim 6 recites, among other features, transmitting additional history data along with the email message, the additional history data including communications exchanges previously conducted between said instant message recipient and said instant message sender, wherein the communications exchanges previously conducted between said instant message recipient and said instant message sender include at least one of email messages, instant messages, and attachments. The Action admits that these features are missing from Daniell. The Action relies on Szeto as showing these features.

In particular, the Action points to Figure 2 and paragraphs 0034 and 0038-0041 of Szeto as showing these features. Paragraph 34 and Figure 2 of Szeto describe and illustrate a history area 228 of a message window 220. The history area 228 includes a sequential display of messages previously exchanged by the users during the course of an instant messaging session. Paragraphs 0038-0041 of Szeto describe an email message including a status indicator 312. However, nowhere does Szeto disclose or suggest transmitting additional history data along with the email message, the additional history data including communications exchanges previously conducted between said instant message recipient and said instant message sender, wherein the communications exchanges previously conducted between said instant message recipient and said instant message sender include at least one of email messages, instant messages, and attachments. Thus, Szeto fails to make up for the deficiencies of Daniell, with regard to the features recited in claim 6. For at least this additional reason, claim 6 is considered allowable over any combination of Daniell and Szeto.

Claim 26 recites similar features as claim 6 and is considered allowable over any combination of Daniell and Szeto for at least the same reasons.

With regard to the rejection of claims 7-12 and 27-32, the Action relies on Danon and Davis for the claimed features missing from Daniell. Danon discloses a method and system for communicating, creating, and interacting with content between and among computing

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devices. Davis discloses client proxying for instant messaging. Neither Danon nor Davis disclose or suggest transmitting history data along with the instant message, the history data including communications exchanges previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments, as set forth in independent claims 1 and 21. Thus, Danon and Davis fail to make up for the deficiencies of Daniell with regard to independent claims 1 and 21. As claims 7-12 and 27-32 depend from and include all the features recited in claims 1 and 21, respectively, claims 7-12 and 27-32 are considered allowable over any combination of Daniell, Danon, and Davis.

With regard to the rejection of claims 13 and 33, the Action relies on Danon for the features missing from Daniell. As explained above, Danon fails to disclose or suggest transmitting history data along with the instant message, the history data including communications exchanges previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments, as set forth in independent claims 1 and 21. Thus, Danon fails to make up for the deficiencies of Daniell with regard to independent claims 1 and 21. As claims 13 and 33 depend from and include all the features recited in claims 1 and 21, claims 13 and 33 are considered allowable over any combination of Daniell and Danon.

With regard to the rejection of claims 14-18, the Action relies on Atencio for the claimed features missing from Daniell. Atencio discloses a system architecture for self-provisioning services and a method of use. Atencio fails to disclose or suggest transmitting history data along with the instant message, the history data including communications exchanges previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments, as set forth in independent claim 1. Thus, Atencio fails to make up for the deficiencies of Daniell with regard to claim 1. As claims 14-18 depend from and include all the features recited in claim 1, claims 14-18 are considered allowable over any combination of Daniell and Atencio.

With regard to the rejection of claims 19, 20, and 39, the Action relies on Roskind for the claimed feature missing from Daniell. Roskind discloses implicit access for a communications pathway. Roskind fails to disclose or suggest transmitting history data along with the instant message, the history data including communications exchanges

previously conducted between the email recipient and the email sender, wherein communications exchanges include at least one of email messages, instant messages, and attachments, as set forth in independent claims 1 and 21. Thus, Roskind fails to make up for the deficiencies of Daniell with regard to independent claims 1 and 21. As claims 19 and 20 and claim 39 depend from and include all the features recited in claims 1 and 21, respectively, claims 19, 20 and 39 are considered allowable over any combination of Daniell and Roskind.

Claim 40

The Action is silent with regard to claim 40. As claim 40 depends from and includes all the features of claim 39, claim 40 is considered allowable for at least the same reasons as claim 39.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fees be charged to Deposit Account No. 09-0457.

Respectfully submitted,

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